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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/065,787	04/23/98	ADAMS R	17275-P043US

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WM02/0508

EXAMINER	
LOGSDON, T	
ART UNIT	**PAPER NUMBER**
2662	6

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/065,787	ADAMS ET AL.	
	Examiner	Art Unit	
	Joe Logsdon	2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-42 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

Claim Rejections—35 U.S.C. 112, Second Paragraph:

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-5 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3-5 and 8-10 recite the term "the message." According to claim 1, "the message" is stored in the service provider; this is the message that will eventually be forwarded to the recipient. According to claims 2 and 7, however, "the message" is sent to inform the recipient of the arrival of the message mentioned in claim 1. It is unclear to which of these "messages" claims 3-5 and 8-10 are intended to refer.

Claim Rejections—35 U.S.C. 102(e):

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1, 6, 11-13, 15-18, 20-22, 30, 31, 33, 35, 36, 39, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown. Brown discloses an apparatus and method for

providing translation services to telecommunications processes for sending an information message over the Internet to an unknown address of a recipient when a unique identifier for the recipient is known (abstract; column 2, lines 56-61). The method comprises the steps of receiving an e-mail message which includes the information message and a unique identifier of the recipient; extracting the identifier from the message and querying a directory server for the address (such as the e-mail address) of the recipient; receiving the address as a response to the query; inserting the address into the information message; and forwarding the resulting message over the Internet (column 2, line 62 to column 3, line 11). A service provider performs these steps, and according to an embodiment the messages are received from the Internet (column 3, lines 17-31). According to an embodiment, a voice messaging system and an e-mail host are used. A telephone subscriber uses the voice messaging system (VMS) to create a voice message. The recipient of the voice message is identified using a telephone number. The VMS converts the voice message to an e-mail format such as SMTP. The VMS then addresses the message and forwards it over the Internet to the SMTP host of the service provider. Upon receiving the message, the SMTP host passes it to an application process that stores it in memory and receives the address from the directory server as described above. Upon receiving the e-mail address, the SMTP host sends the translated voice message to the recipient's e-mail mailbox (column 4, lines 30-46; column 4, line 53 to column 5, line 7). The invention inherently involves push technology because no action on the part of the recipient is required for delivery of the message to the recipient's mailbox.

Claim Rejections—35 U.S.C. 103(a):

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 7, 14, 19, 32, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Burg. Brown fails to teach that the called party is notified of the incoming call. Burg discloses an apparatus and method which allow a called party to connect to a data network using a telephone transmission line (abstract). If the called party's computer is logged into the network, a telephony gateway notifies the called party of the incoming call; the format and content of the received message, as well as options for handling the call, are provided to the called party (column 4, line 66 to column 5, line 16; column 8, lines 38-42). The transmission of the notification is inherently nearly simultaneous with the transmission of the translated voice

message if the recipient is logged onto the network. This type of notification is by definition a page, and it is a short message. It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that the called party is informed when an incoming call arrives, and the called party is informed of the format and options for handling the call, as in Burg, because such an arrangement allows the caller and called party to communicate as soon as either party desires to communicate, which is the primary motivation for converting voice into e-mail.

8. Claims 3, 8, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown and Burg, as applied to claims 2, 7, and 32 above, and further in view of Emery et al. Neither Brown nor Burg teaches the option of using a wireless network. Emery et al. discloses a system and method in which an advanced intelligent network (AIN) wireline system connects to and controls processing of calls to a personal communication service subscriber's wireless communication network (abstract). It would have been obvious to one of ordinary skill in the art to modify the inventions of Brown and Burg so that they use wireless communication networks, as in Emery et al., because such an arrangement would provide a communication service that is adaptable to each user's individual lifestyle.

9. Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Burg and Emery et al. Brown discloses an apparatus and method for providing translation services to telecommunications processes for sending an information message over the Internet to an unknown address of a recipient hen a unique identifier for the recipient is

known (abstract; column 2, lines 56-61). The method comprises the steps of receiving an e-mail message which includes the information message and a unique identifier of the recipient; extracting the identifier from the message and querying a directory server for the address (such as the e-mail address) of the recipient; receiving the address as a response to the query; inserting the address into the information message; and forwarding the resulting message over the Internet (column 2, line 62 to column 3, line 11). A service provider performs these steps, and according to an embodiment the messages are received from the Internet (column 3, lines 17-31). According to an embodiment, a voice messaging system and an e-mail host are used. A telephone subscriber uses the voice messaging system (VMS) to create a voice message. The recipient of the voice message is identified using a telephone number. The VMS converts the voice message to an e-mail format such as SMTP. The VMS then addresses the message and forwards it over the Internet to the SMTP host of the service provider. Upon receiving the message, the SMTP host passes it to an application process that stores it in memory and receives the address from the directory server as described above. Upon receiving the e-mail address, the SMTP host sends the translated voice message to the recipient's e-mail mailbox (column 4, lines 30-46; column 4, line 53 to column 5, line 7). Brown fails to teach that the called party is notified of the incoming call. Burg discloses an apparatus and method that allow a called party to connect to a data network using a telephone transmission line (abstract). If the called party's computer is logged into the network, a telephony gateway notifies the called party of the incoming call; the format and content of the received message, as well as options for handling the call, are provided to the called party (column 4, line 66 to column 5, line 16; column 8, lines 38-42). The transmission of the notification is inherently nearly simultaneous with the transmission of the

translated voice message if the recipient is logged onto the network. This type of notification is by definition a page, and it is a short message. It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that the called party is informed when an incoming call arrives, and the called party is informed of the format and options for handling the call, as in Burg, because such an arrangement allows the caller and called party to communicate as soon as either party desires to communicate, which is the primary motivation for converting voice into e-mail. Brown further fails to teach the option of using a wireless network. Emery et al. discloses a system and method in which an advanced intelligent network (AIN) wireline system connects to and controls processing of calls to a personal communication service subscriber's wireless communication network (abstract). It would have been obvious to one of ordinary skill in the art to modify the inventions of Brown and Burg so that they use wireless communication networks, as in Emery et al., because such an arrangement would provide a communication service that is adaptable to each user's individual lifestyle.

10. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Finnigan. Brown fails to teach a certification means. Finnigan discloses a voice message store and forward service in which notification of success or failure of the message transfer is provided (column 2, lines 38-42; column 9, lines 40-53; claim 2). It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that certification is provided, as in Finnigan, because certification provides proof of receipt of the message.

11. Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of the Admitted Prior Art. Brown fails to teach the use of means for recognizing touch tone codes as representing network addresses. The Admitted Prior Art teaches that an established prior art protocol may be used to enter an address using the touch tone keys (page 8, lines 8-10). It would have been obvious to one of ordinary skill in the art to modify the invention of Brown so that the identifier is entered using touch tones because such an arrangement would allow callers to easily and quickly provide the address of the recipient using a readily available touch tone telephone.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. MacMillan, Jr. et al. and Neyman are cited to show the state of the art.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Logsdon whose telephone number is (703) 305-2419. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou, can be reached at (703) 305-4744.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 308-6743

For informal or draft communications, please label "PROPOSED" or "DRAFT".

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Joe Logsdon

Patent Examiner

April 22, 2001

HASSAN KIZOU
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